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SUPREME COURT OF THE UNITED STATES

October Term, 1941

No. 718

GENERAL MOTORS CORPORATION,
Petitioner,

v.

CONWAY P. COE, Commissioner of Patents,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

GENERAL MOTORS CORPORATION,
By DRURY W. COOPER,
FRANK E. LIVERANCE, JR.,
Counsel for Petitioner.

AMERICAN BRIEF AND RECORD CO., GRAND RAPIDS, MICHIGAN

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

To the Honorable The Chief Justice and Associate Justices of The Supreme Court of The United States:

Your petitioner, GENERAL MOTORS CORPORATION, respectfully prays that a writ of certiorari issue to the United States Court of Appeals for the District of Columbia to review the judgment of that Court entered in the above-entitled cause on June 16th, 1941 (R. 458). A petition for rehearing was denied by the said Court of Appeals on August 1st, 1941 (R. 458). A certified Transcript of Record in this cause including the proceedings in the said Court of Appeals is furnished in accordance with Rule 38 of this Court.

Summary and Short Statement

This action was brought in the District Court for the District of Columbia under the Act of March 2, 1929, C. 488, Sec. 2 (b), 45 Stat. 1476, R.S. Sec. 4915 (U. S. Code, Title 35, Sec. 63, as amended March 2, 1929) to obtain

Letters Patent for an invention of Ernest E. Wilson, assigned to your petitioner.

Wilson's invention is for a silencer by which the intake or exhaust noise of an internal combustion engine may be silenced without restricting air entrance into or exhaust gas discharge from the engine cylinders. The Wilson application illustrates (R. 143-144) a number of forms of the silencer.

Restriction of exhaust gas discharge from its cylinders lowers, and restriction of air entrance into its cylinders much more pronouncedly lowers the efficiency of an engine (R. 16-17, 26; 38-40; 55-57, 59). This had long been universally recognized and a silencer which would not restrict air entrance into or the exhaust gas discharge from the cylinders of an engine had long been sought. At the time Wilson made his invention all exhaust silencers in use inherently considerably restricted exhaust gas discharge from the cylinders; and few intake silencers were used,* because none were available which would not unduly restrict air entrance into the cylinders of the engine resulting in loss of power and increased fuel consumption (R. 16-17; 26; 37-40; 50; 57).

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*Wilson testified that he knew of but two (R. 16). Kamrath, silencer engineer for AC Spark Plug Division of your petitioner, identified these as the Nash silencer, Exhibits 11 and 12 and the Buick silencer, Exhibit 13 and testified that they were displaced by the Wilson silencer as soon as it became available (R. 37-40).

Silencers of Wilson's invention have concededly attained "great commercial success"* (R. 455). They represent the only known means of silencing intake or exhaust noises of an engine without lessening its efficiency. Lessened efficiency means reducing the horsepower available and increasing fuel consumption — a matter of concern at all times, and especially at present.

Wilson's silencers are based on a principle of acoustics — a Helmholtz resonator's capability of attenuating sound waves whose frequency equals its natural frequency — known to the world before 1896** but not prior to Wilson's invention applied to any practical use. Wilson was told by associates that the principle could not be employed to silence the intake or exhaust noises of an engine (R. 25). Of course, Wilson's invention involved much more than just connecting a Helmholtz resonator to intake or exhaust pipes of an engine. The U. S. Court of Appeals D. C. has recognized the *great importance* of the *modifications* made in chambers of the prior art to apply the teachings of Rayleigh (R. 456). Lord Rayleigh's treatise in date was long before automobiles were

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*Intake silencers in accordance with Wilson's invention were first put on the market in 1930. Within a short time they were standard original equipment on *all* automobiles made in this country. At the time of the trial in the District Court (November 1939) nineteen million (19,000,000) of them had been made and used in this country. Wilson's invention thus created a new industry. Exhaust silencers in accordance with Wilson's invention are standard original equipment on several automobiles made in this country. Silencers in accordance with Wilson's invention are also used on a number of trucks and tractors made in this country and on a number of automotive vehicles made in foreign countries (R. 24-25; 30; 37; 41-43).

**The principle is referred to in the *second* (1896) edition of Lord Rayleigh's treatise entitled "Theory of Sound" (R. 368); and Dr. Chamberlain testified (R. 80) in periodicals of earlier date.

anything but curiosities. No one prior to Wilson, during 30 years of intensive automotive development, got the invention because of this treatise. Yet without this publication of Lord Rayleigh there could have been no basis for even a doubt as to invention being present in the Wilson development.

The Wilson application was filed on July 25, 1930. Broad claims were allowed — on November 4, 1931 (R. 81) by one Examiner and on July 28, 1932 (R. 192) after reexamination by his successor. Thereafter the Wilson application was in interferences, all won by Wilson. After the interferences the successor to the second Examiner reexamined the Wilson application and rejected the broader of the claims allowed by his predecessors.

The third Examiner eventually finally rejected the broader claims before him. The Board of Appeals of the Patent Office in a manifestly ill considered decision affirmed his decision except as to three of these claims (R. 443-452).

The District Court allowed two of the claims refused by the Board but dismissed your petitioner's bill as to the remainder as not patentable over the prior art of record (R. 89). Claim 92, (R. 4), allowed by the District Court, differs from most of the claims (e.g. claim 109, R. 5) disallowed by the District Court and the Court of Appeals only in the addition of an old feature which is clearly disclosed in the prior patent to Powell (R. 304). That is, the novelty upon which the allowance of claim 92 must have been predicated — the tuning, or the dimensioning of the resonator — is also defined in most of the claims disallowed by the District Court. The District Court made no findings of fact (R. 90-92) to support its conclusion that the claims it disallowed were not patentable over the prior art of record.

The Court of Appeals refused (R. 457) to consider the circumstance that the inventive novelty upon which claim 92 must have been allowed was also found in most of the claims before it. It also refused (R. 456-457) to consider the long period between the publication of Lord

Rayleigh's treatise and Wilson's invention as evidence, with respect to the claims before it, of invention in applying the principle disclosed in Lord Rayleigh's treatise to internal combustion engine intake and exhaust silencers.

The Court of Appeals conceded that Wilson's invention had attained "great commercial success", that the automobile engine silencers in the prior art of record do not operate as resonators (R. 455), that the modifications required to apply to automobile engine mufflers of the principle disclosed in Lord Rayleigh's treatise were "of great importance" (R. 456) and that "the presence or absence of invention is doubtful in this case" (R. 456). But the Court of Appeals affirmed the decision of the District Court because it said

> "we cannot say that it (the application of principle disclosed in Lord Rayleigh's treatise to internal combustion engine silencers) clearly required the uncommon talent of an inventor"

and

> " 'Whatever else may be said of older decisions that, in appeals from the Patent Office, doubt was to be resolved in favor of the applicant, they are obviously not law in relation to appeals from the District Court.' It is the settled law of this Court that we must sustain the findings of the Patent Office and the District Court unless we think them clearly wrong. In other words doubt is to be resolved, in suits to obtain a patent as in suits of other sorts, in favor of the correctness of administrative and judicial action."

It is clear from the opinion of the Court of Appeals that its doubt of the lack of invention in this case was a substantial, well-founded doubt and that the Court resolved this doubt against your petitioner, notwithstanding the advance made was accompanied by recognized in-

dicia of inventions, and there was disagreement within and among the tribunals below.***

The Questions Presented by this Petition

The decision of the Court of Appeals obviously turned upon whether the Court should resolve substantial, well-founded doubt respecting lack of invention in favor of or against the applicant. Notwithstanding the advance was accompanied by recognized indicia of invention*; and there was disagreement within and among the tribunals below,** the Court resolved such doubt against the ap-

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*The Court of Appeals conceded that what Wilson did was novel, "of great importance" and "achieved great commercial success." But this brief resume does not do Wilson's invention justice. It was the long sought for solution to the problem of how to silence the intake or exhaust of an engine without reducing its efficiency and the first and only satisfactory solution to the problem of silencing the intake. It increased the horsepower available from and reduced the fuel consumption of engines. It immediately supplanted and superseded the few intake silencers in use at the time it became available and within a short time was *standard original equipment* on *all automobiles* made in this country. It created the intake silencer industry. Rayleigh's treatise without which invention would never have been questioned is of ancient vintage. It was not to be expected that the principle referred to in Rayleigh's treatise could be used to silence an engine. In the case of most of the claims involved in the appeal their disallowance was inconsistent with the allowance of claim 92. All of these things are amply established and none of them except that need for the invention was long felt is questioned by the Court of Appeals.

**The presumption of correctness of the decisions of lower tribunals is weakened by disagreement within and among them. *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corporation et al,* 294 U. S. 477, 480; *In re Wilson,* 49 App. D. C. ———, 258 F. 976.

plicant because it said, quoting dictum from *Minnesota Mining & Mfg. Co. v. Coe,* 118 F. (2d) 593, 594:

> "Whatever else may be said of older decisions that, in appeals from the Patent Office, doubt was to be resolved in favor of the applicant they are obviously not law in relation to appeals from the District Court."

The decision of the Court of Appeals of the District of Columbia, consequently, presents the following questions:

The First Question

Whether the United States Court of Appeals for the District of Columbia in an action under R.S. Sec. 4915 against the Commissioner of Patents should resolve against the applicant for patent substantial, well-founded doubt of lack of invention in the advance for which a patent is sought.

The Second Question

This question need be considered only in the event the preceding question is answered in the affirmative. It is:

Whether the United States Court of Appeals for the District of Columbia in an action under Sec. 4915 R.S. against the Commissioner of Patents should resolve substantial, well-founded doubt of lack of invention in the advance for which a patent is sought against the applicant for patent in a case in which in addition to substantial novelty there is conceded "great importance", "great commercial success", and there was disagreement within and among the tribunals below.

The Third Question

If the first question or the second question is answered in the negative this question need not be considered. It is:

Whether the United States Court of Appeals for the District of Columbia, in an action under Sec. 4915 R.S. against the Commissioner of Patents, should resolve substantial well-founded doubt of lack of invention in the advance for which a patent was sought against the applicant for a patent in a case in which in addition to substantial novelty the Court conceded "great importance" and "great commercial success", there was disagreement within and among the tribunals below, and the following circumstances also obtain:

The advance was the first and only satisfactory solution to a problem which had long existed and been recognized. It resulted in increase in efficiency and reduction in cost of operation. It immediately supplanted and superseded the few things in use in an important field of its application and within a short time was used universally and *exclusively* in that field. It created a new industry. A prior art item without which invention would never have been questioned is of ancient vintage. It was not to be expected that the principle referred to in the prior art item could be used to do what the applicant's invention does. In the case of most of the claims involved in the appeal their disallowance is inconsistent with the allowance of another claim.

The Reasons Relied Upon for the Grant of the Writ

I.

The questions presented by the decision of the Court of Appeals in this cause are of great importance to inventors, industry and the country as a whole.

II.

The precise questions presented by the decision of the Court of Appeals in this cause have not been passed on by the Supreme Court.

III.

The decision of the Court of Appeals on the questions presented by its decision in this cause is in conflict with the applicable decisions of the Supreme Court.

IV.

The decision of the Court of Appeals on the questions presented by its decision in this cause is in conflict with the decisions of all other tribunals which deal with applications for patents.

V.

The decision of the Court of Appeals on the questions presented by its decision in this cause is in conflict with the decisions of the same Court in appeals from the Patent Office and with other decisions by it in actions against the Commissioner of Patents under R.S. Sec. 4915.

VI.

There is disagreement within the Court of Appeals itself with respect to the proper answers to the questions presented by its decision in this cause.

VII.

Conflict between the decision of the United States Court of Appeals for the District of Columbia and a decision of another United States Court of Appeals on the questions presented by the decision of the former in this cause is wholly unlikely.

VIII.

The decision of the Court of Appeals on the questions presented by its decision in this cause results from confusion and misapplication of two entirely separate and distinct rules of law, viz., the rule that substantial, well-

founded doubt as to lack of invention should be resolved in favor of the applicant, and the rule that the decisions of lower tribunals are presumed to be correct and are not to be reversed just because of doubt as to their correctness.

Wherefore, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Court directed to the United States Court of Appeals for the District of Columbia, commanding said Court of Appeals to certify and send to this Court on a day to be designated a full Transcript of the Record and all proceedings had in the said Court of Appeals in this cause, to the end that the same may be reviewed and determined by this Court; and the judgment of said Court of Appeals be reversed and that petitioner be granted such other and further relief as may be deemed proper.

GENERAL MOTORS CORPORATION,
Petitioner.
By DRURY W. COOPER,
FRANK E. LIVERANCE, JR.,
Counsel for Petitioner.

October 16, 1941.